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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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KEVIN T. McCARNEY, dba	)	
POQUITO MAS,	)	Opposition No. 107,026
	)	Opposition No. 107,048
Opposer,	)	
v.	)	
UNA MAS, INC.,	)	
Applicant.	)	
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BOX TTAB - NO FEE  
Asst. Commissioner of Trademarks  
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Arlington, Virginia 22202-3513

**OPPOSER'S REPLY BRIEF**

Opposer, Poquito Mas, hereby replies to Applicant, Una Mas, Inc.'s, response to Applicant's Brief.

I hereby certify that this correspondence is being deposited  
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on 02-26-03

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February 26, 2003

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## **TABLE OF CONTENTS**

### **I. INTRODUCTION**

- A. The Survey Taken by Applicant Should at Best be Given Little Weight
- B. Trade Dress and Commercial Impression are Relevant
- C. There are Instances of Actual Confusion
- D. Opposer and Applicant Have Not Coexisted
- E. POQUITO MAS is a Strong Mark
- F. The Testimony of Christine P. Peters Includes Inadmissible Hearsay Evidence and Does Not Show that POQUITO MAS is Weak
- G. Actual versus Recited services

### **II. SUMMARY**

### **III. CONCLUSION**

### **IV. RELIEF REQUESTED**

## **TABLE OF CASES**

- Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597, 1603 (TTAB 1990);
- AmBrit, Inc. v. Kraft, Inc.*, 1 USPQ2d 1161 (11<sup>th</sup> Cir. 1986);
- AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973);
- Arachnid, Inc. v. Medalist Mktg. Corp.*, 1991 U.S. Dist. LEXIS 9055, \*8 [18 USPQ2d 1941] (W.D. Wash. 1991) *aff'd*, 972 F.2d 1300 [23 USPQ2d 1946] (Fed. Cir. 1992);
- Armco, Inc. v. Armco Burglar Alarm Co., Inc.*, 693 F.2d 1155, 1160n.10 [217 USPQ 145] (5th Cir. 1982);
- Block Drug Co. v. Den-Mat Inc.*, 17 USPQ2d 1315, 1318 (TTAB 1989);
- Burger Chef Systems, Inc. v. Burger Man, Inc.*, 181 USPQ 168 at 169 (C.C.P.A. 1974);

*Carl Karcher Enterprises, Inc. v. Stars Restaurants, Corp.*, 35 USPQ2d 1125 at 1129 (T.T.A.B.1995);  
*Centaur Communications Ltd. v. A/S/M Communications Inc.*, (DC SNY) 1 USPQ2d 1958 (1/14/1987);  
*Continental Graphics Corp.*, 52 USPQ 2d 1374, 1375 (TTAB 1999);  
*Dixie Restaurants, Inc.*, 41 USPQ2d 1531 at 1534 (C.A.F.C. 1997);  
*E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973);  
*Freddie Fuddruckers, Inc. v. Ridgeline, Inc.*, 589 F. Supp.72, 76 [223 USPQ 1139] (N.D. Tex. 1984)  
*Fuddrucker's, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 845 [4 USPQ2d 1026] (9th Cir. 1987);  
*Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ 390, 395 (C.A.F.C. 1983);  
*Gillette Canada Inc. v. Ranir Corp.*, (TTAB) 23 USPQ2d 1768 at 1774 (6/24/1992);  
*Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738, 742 (TTAB 1978);  
*Hutchinson v. Essence Communications, Inc.*, 769 F.Supp 541, 559-560 (SDNY 1991);  
*J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ 1889, 1892 (Fed. Cir. 1991);  
*Kraft General Foods Inc. v. BC-USA Inc.*, (DC EPa) 29 USPQ2d 1919 at 1922;  
*Olde Tyme Foods Inc. v. Roundy's Inc.*, (CA FC) 22 USPQ2d 1542 (4/17/1992);  
*Planter's Nut & Chocolate Company v. Crown Nut Company, Inc.*, 134 USPQ 504 (CCPA 1962);  
*Scandia Down Corp. v. Euroguilt, Inc.*, 227 USPQ 138 (7th Cir. 1985);  
*Special Brands* at 1285; 1288;  
*Spice Islands, Inc. v. Frank Tea and Spice Company*, 184 USPQ 35 (CCPA 1974);  
*Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991);  
Thomas J. McCarthy, McCarthy on Trademarks and Unfair Competition §23:14; §23:17; §32:159;  
*Toys "R" Us v. Canarsie Kiddie Shop, Inc.*, 559 F.Supp. 1189, 1205 [217 USPQ 1137, 1149] (E.D.N.Y. 1983).

## INTRODUCTION

Applicant is attempting to reply on a faulty survey and hearsay evidence to overcome the fact that a review of the DuPont factors clearly shows a likelihood of confusion. Applicant has conceded many of the factors and only discusses a few selected factors in its brief. In this respect, the vast majority of the DuPont factors weigh in favor of a finding a likelihood of confusion. Set forth below is a summary of the DuPont factors and the application of these factors to these proceedings which were discussed in greater detail in Opposer's main brief.

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; POQUITO MAS and UNA MAS both have only two words which include clear Spanish origin. Opposer's mark POQUITO MAS has a translated meaning of "little more" while UNA MAS is translated to "one more." While not identical, these meanings are virtually identical.

2. The similarities or dissimilarities of the services; the actual and recited services are identical.

3. The similarities or dissimilarities of established, likely to continue trade channels; the trade channels are identical.

4. The condition under which sales are made and buyers to whom sales are made; the services recited in Applicant's application and Opposer's registrations include fast-food services which are purchased without significant consideration as to source, which are low cost and which are presented to the general public. The actual services provided by both parties compete with fast-food restaurants. These

are the types of services which increase the possibility of a likelihood of confusion existing. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991); *Special Brand* at 1288; *Spice Islands, Inc. v. Frank Tea and Spice Company*, 184 USPQ 35 (CCPA 1974). In fact, fast food is often purchased on impulse. *Carl Karcher Enterprises, Inc. v. Stars Restaurants, Corp.*, 35 USPQ 2d 1125 at 1129 (T.T.A.B. 1995).

5. The fame of Opposer's mark; Opposer's POQUITO MAS mark is a strong mark. Word-of-mouth is a large part of the advertisement for restaurant services. *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531 at 1534 (C.A.F.C. 1997) citing *Giant Foods, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ 390, 395 (C.A.F.C. 1983). The POQUITO MAS mark has been used by Opposer for more than 18 years in a major metropolitan area and has been repeatedly featured in major newspapers in the major metropolitan area.

6. The number and nature of similar marks in use on similar services; as will be discussed in greater detail below, even after extensive searching, Applicant has failed to provide credible evidence that others use a mark which weakens Opposer's POQUITO MAS mark. Self serving hearsay testimony is not sufficient to show use of a mark. Further, even with the few menus showing use, no evidence was provided which show the way in which the marks are used and the extent of use. These menus do not show that Opposer's mark is weak.

7. The nature and extent of actual confusion; even with the geographic separation of the parties and the nature of the services, incidences of actual confusion

exist. Four incidences of actual confusion have been considered sufficient to show a likelihood of confusion exists when inexpensive goods were involved. Thomas J. McCarthy, McCarthy on Trademarks and Unfair Competition §23:17 citing *AmBrit, Inc. v. Kraft, Inc.* 1 USPQ2d 1161 (11<sup>th</sup> Cir. 1986).

8. The length of time during and conditions under which there have been concurrent use without evidence of actual confusion; Opposer's POQUITO MAS mark and Applicant's UNA MAS mark have not been in use in the same geographic region. Therefore, there has been no concurrent use. Poquito Mas operates its restaurants in the Los Angeles area while Una Mas operates its restaurants in the San Francisco area.

9. The variety of goods/services on which the mark is used; both parties use the marks of these proceedings in connection with Mexican restaurant services.

10. The market interface between the parties. Opposer has not consented to Applicant's use and has taken action against Applicant's use of UNA MAS.

11. The extent to which Opposer has the right to exclude others from using the mark. Opposer is the owner of 18 years of common law rights and an incontestable Federal registration for the mark POQUITO MAS for restaurant services which give Opposer the right to exclude under the Lanham Act.

12. The extent of potential confusion; the actual use by each party is identical. Both parties operate virtually identical taco-style Mexican restaurants. Both are expanding use and will likely be in the same geographic location in the near future.

Even when the few factors Applicant believes weighs in its favor are reviewed, they individually fail to support the lack of a likelihood of confusion. POQUITO MAS and UNA MAS are similar in sight, sound and connotation. Opposer agrees with Applicant that this analysis is not meant to be a side-by-side analysis, but rather a review of the overall commercial impression that the marks present to the consumer. *In re Continental Graphics Corp.*, 52 USPQ 2d 1374, 1375 (TTAB 1999). Opposer's POQUITO MAS mark and Applicant's UNA MAS mark consist of two words. Further, these two words have clear Spanish origin to the consumer of the services involved in these proceedings. Both marks use the word MAS as a second word in connection with a beginning Spanish word which, based on usage, is the type of word which naturally precedes the word MAS. The words together create virtually identical commercial impressions. POQUITO MAS has an English translated meaning of "little more" and UNA MAS has an English translated meaning of "one more." While the differences in POQUITO and UNA create some differences in sight and sound, the overall commercial impression produced by these two marks is virtually identical. Applicant's contention that "little more" and "one more" are in no way similar is absurd.

Applicant has failed to provide evidence that the consumer of the services of these proceedings would be sufficiently fluent in the Spanish language to distinguish between the slight differences in the meaning of these phrases. In fact, U.S. consumers of restaurant services are more likely to have only a vague notion of these words. This is especially true based on the likely scenerio in which the consumer views marks used for restaurant services wherein the consumer is not likely to see Opposer's POQUITO MAS mark and Applicant's UNA MAS mark side-by-side one another or at the same time. The consumer is more likely to view one mark and then at a later time and/or date, view the other mark. Based on this likely scenerio, the vague notion produced by POQUITO

MAS of "little more" will likely blend together with the vague notion produced by the UNA MAS mark of "one more." Accordingly, when the marks of this proceeding are reviewed in the way in which they will be seen by the consumer, the overall impression of the marks is very similar.

**A. The Survey Taken by Applicant Should at Best be Given Little Weight**

As an initial matter, Opposer cannot believe that Applicant is taking the position that the Board is unable to evaluate Applicant's survey without outside assistance by an opposing expert witness.

Ms. Mobilio is not an expert in the field of likelihood of confusion surveys and, therefore, is not qualified to create, oversee and/or testify in connection with such a survey. Applicant has failed to establish that Mobilio is qualified to testify in these proceedings and has failed to show that the results are trustworthy and, therefore the testimony of Mobilio and the survey should be stricken from the record.

The trustworthiness of a survey depends upon a demonstration by its proponent that "(1) the 'universe,' was properly defined, (2) a representative sample of that universe was selected, (3) the questions to be asked of interviewees were framed in a clear, precise and non-leading manner, (4) sound interview procedures were followed by competent interviewers who had no knowledge of the litigation or the purpose for which the survey was conducted, (5) the data gathered was accurately reported, (6) the data was analyzed in accordance with accepted statistical principles, and (7) objectivity of the entire process was assured."

*Centaur Communications Ltd. v. A/S/M Communications Inc.*, (DC SNY) 1 USPQ2d 1958 (1/14/1987) citing *Toys "R" Us v. Canarsie Kiddie Shop, Inc.*, 559 F.Supp. 1189, 1205 [217 USPQ 1137, 1149] (E.D.N.Y. 1983). Applicant has failed to show that Mobilio is an expert and that the survey is trustworthy.



While Mobilio may have a college background in psychology, this is not sufficient in itself to make one an expert in the complexities of a likelihood of confusion survey. The record shows that Mobilio graduated just two years before the survey was performed and had no experience in likelihood of confusion surveys when designing the survey, when implementing the survey and when testifying about the survey. In fact, Mobilio had not on any prior occasion designed or even been involved in a likelihood of confusion survey before she designed the survey. Mobilio test; Pg. 39, lines 9-12. This survey was Mobilio's first likelihood of confusion survey. Mobilio test; Pg. 39, lines 13-15. In fact, the last time and only time Mobilio testified as an expert was in a child custody case. Mobilio test; Pg. 40, lines 1-12. A college degree is not enough to make someone an expert able to design, implement and testify in relation to the whether a likelihood of confusion exists. Experience in brand awareness surveys hardly makes one an expert in likelihood of confusion surveys. Opposer again makes its objection to the testimony of Mobilio. Applicant has failed to satisfied its burden of showing that Mobilio qualifies as an expert. In fact, Mobilio is not an expert in the field of likelihood of confusion surveys which is the subject of these proceedings and, therefore, her testimony should be stricken from the record.

Even if the survey is considered, it includes many flaws and should be given little or no weight. Mobilio's inexperience in likelihood of confusion surveys is evident in that the survey doesn't even address the primary issue of these proceedings. As the Board is well aware, the issues of these proceedings involve the **Federal** registration of a service mark which affords the owner many rights including national rights for use of its mark. These proceedings are not concerned with whether Opposer and Applicant can coexist in two separate and geographically spaced regions. Conversely, these proceedings involve national rights which would allow Applicant to provide its

services under the UNA MAS mark in the same location as Opposer. Mobilio testified that the survey only addresses consumer belief as of the date of the survey when Opposer and Applicant are operating in separate geographic regions. Mobilio test; Pg. 79, lines 3-8. When asked whether Mobilio had “any opinion as to what would happen in the future if POQUITO MAS stores were to begin to open in neighborhoods where there are UNA MAS stores or vice versa,” Mobilio had no opinion. Mobilio test; Pg. 79, lines 9-13. Again, national rights are involved and a survey which, by the testimony of the survey taker, only relates to whether Opposer and Applicant can coexist in two geographically space regions, has no value.

The survey universe is improper, therefore, if the survey is considered, it should be afforded only minimal weight. McCarthy on Trademarks §32:159 citing *Hutchinson v. Essence Communications, Inc.*, 769 F.Supp 541, 559-560 (SDNY 1991). The wrong survey universe is of little probative value. *Id.* Mobilio agreed and in her testimony stated the questions asked test takers “aren’t relevant to someone who doesn’t eat out or take out from Mexican food restaurants.” Mobilio test; Pg. 17, lines 19-21. However, the universe chosen for the survey includes those who have not eaten at a Mexican restaurant nor intend to eat at a Mexican restaurant. In order to save money, Applicant created a survey to handle two different legal proceedings. The other legal proceeding involved an Italian food restaurant. As a result, the universe for the survey improperly includes those who have “[e]aten at or taken out from Mexican food restaurants in the past 6 months AND intend to do so in the next 6 months, OR [e]aten at or taken out from pizzerias or pizza parlors in the past 6 months AND intend to do so in the next 6 months.” Mobilio test; Exh. 2, page 1 of survey. The test takers who fall into the second category relating to pizza patrons improperly influence the survey universe and further reduce the value of the survey. In addition, inclusion of

questions directed to pizzerias adversely increased the time necessary to administer the survey to each survey taker and increased the complexity of the survey which will be discussed in greater detail below.

The survey was limited to phonetic similarities in the marks and the phonetics of the respective marks were incorrectly conveyed to the test givers. The survey performed by Mobilio was a telephone survey. As the Board knows, and as Mobilio stated in her testimony, the use of the correct pronunciation is important with a telephone survey. Mobilio test. Pg. 59 lines 3-4. In view of the importance, the test takers were provided with phonetic guides for each mark. Mobilio test. Pg. 59 lines 9-10 and page IV of survey. Further, since Mobilio was not present during the actual interviews, she can only testify that the test givers followed her instructions. Mobilio test. Pg. 59 lines 15-17. The marks involved in these proceedings are POQUITO MAS and UNA MAS. The phonetic equivalent given to the test givers was “POE-KEE-TOE MOSS” AND “OONAH MOSS,” respectively. The second word of the marks involved is not pronounced “MOSS” which is understood by the United States consumer to represent a small leafy plant which is commonly found on trees. Conversely, the marks of these proceedings both include the word MAS. Applicant has not provided any evidence that “MOSS” is the correct pronunciation for this term and, in fact, it is not the correct pronunciation. By using a word which has a common English equivalent, the test givers did nothing more than pronounce the word as it is pronounced to describe a specific type of plant. The sound of Spanish word ‘MAS’ along with its Spanish meaning is an important aspect of the analysis to determine whether a likelihood of confusion exists. The fact that the test takers, who are relying on only sound, likely never had a chance to fully appreciate the commercial impression of these marks further shows that the survey should be given little or no weight. Since the survey

improperly related to both Mexican and Italian derived restaurant names, the test taker likely failed to mentally make the correction to the improper pronunciation of the test giver.

As Applicant properly emphasized in its brief, “the test [for similarities in sight, sound and connotation] is not whether the marks can be distinguished when subject to a side-by-side comparison.” Una Mas Brief, page 9, quoting *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1375 (TTAB 1999). The selection of fast-food type restaurant services is done on the “basis of casual recollection of what they may have experienced in other places at other times.” *Carl Karcher Enterprises, Inc. v. Stars Restaurants, Corp.*, 35 USPQ 2d 1125 at 1129 (T.T.A.B. 1995) citing *Burger Chef Systems, Inc. v. Burger Man, Inc.*, 181 USPQ 168 at 169 (C.C.P.A. 1974). The survey performed by Applicant listed the names one after the other in a side-by-side manner which does not fully represent the way the marks are actually used. Furthermore, limiting the marks to sound only presentations, does not fully represent the way in which these marks are used including similarities in menus, similarities in food items, and similarities in restaurant formats.

While Applicant argues that the other similarities, such as virtually identical menu items and trade dress similarities are not apart of this analysis, the application for UNA MAS is in typewritten form and recites services which are identical to Opposer’s services. Therefore, the analysis of whether a likelihood of confusion exists must include the full scope of the rights which Applicant’s application will provide if it is allowed to issue as a registration. These rights include the current situation where Applicant is using UNA MAS in connection with a restaurant which is virtually identical to Opposer’s restaurant. The survey doesn’t in any way account for these other similarities further showing that if it is considered, it should be given little or no weight.

The actual test took, on the average, almost twice as long as anticipated by Mobilio. Mobilio test. Pg. 20 lines 9-10. First, this further shows the lack of experience by Mobilio in this type of survey. Second, the test taker, who was told up-front that the test would only take five minutes, was kept on the phone for an average of nine minutes. As a result, the complicated final questions relating to the test taker analyzing common ownership and providing an opinion were asked well after the test taker believed he or she would be done with the survey. Applicant has failed to show that the test givers maintain the attention and cooperation of the test takers even though the time necessary to administer the test was almost twice as long as indicated when the test taker agreed to participate in the survey.

Even with all of the flaws discussed above and the limited scope of the information provided the test taker (sound only), 17 people were confused. The most interesting test taker is Case ID 140 who participated in the survey. The test taker 140's response fits the factual conditions of these proceedings and shows what will happen when the geographic gap between Opposer and Applicant is bridged. In this respect, the POQUITO MAS service mark is used in Southern California, namely, Los Angeles. (McCarney Testimony 10, 6-8, Exh. 5, 6 and 11). Applicant operates its chain of Mexican restaurants in and about the San Francisco Bay area. (McCarney Testimony 81, 11-24 and Exh. 29). Test taker 140 reason for believing POQUITO MAS and UNA MAS are related was "mainly because there is more than one of them; they have a lot of them in Southern California. The likely scenario is that when test taker 140 traveled to Southern California, he or she viewed Opposer's POQUITO MAS restaurant and the many other similarities not able to be communicated by a telephone survey and as a result, believes there is common ownership.

In summary, the survey and the testimony of Mobilio should be stricken from the record. Applicant has not satisfied its burden of establishing Mobilio as an expert nor has it established that it is trustworthy. Mobilio has never conducted a likelihood of confusion survey and has never even work in connection with a likelihood of confusion survey. A psychology degree in itself doesn't qualify someone as an expert in the complex field of surveys relating to the issue of whether a likelihood of confusion exists. Performing surveys on brand awareness does not overcome Mobilio's deficiencies and qualify Mobilio as an expert in likelihood of confusion surveys.

Even if the survey is considered, Mobilio admitted that the survey doesn't even address the primary issue of these proceedings, namely, what would happen in the future if UNA MAS restaurants were to begin to open in neighborhoods where there are POQUITO MAS restaurants or vice versa. Mobilio had no opinion of what would happen under those circumstances. The survey universe also improperly included persons who do not eat out or take out from Mexican food restaurants. The telephone survey, which was limited to phonetic similarities in the marks, utilized the incorrect phonetics of the word MAS. The selection of fast-food type restaurant services is done on the "basis of casual recollection of what they may have experienced in other places at other times." Carl Karcher citing Burger Chef (supra). The telephone does not fully represent a "casual recollection." Further, the survey was not designed to capture the flavor of the marketplace from which a likelihood of confusion could arise. "While survey evidence is sometimes said to be evidence of 'actual' confusion, it is so only to the extent that the survey replicates the real world setting which can create an instance of actual confusion." McCarthy on Trademarks §23:17. The survey presented by Applicant does not replicate the real world setting. The actual test also took, on the average, almost twice as long as anticipated by Mobilio and as was conveyed to the test takers

at the beginning of the interview. Finally, even with all the flaws and the limited nature of a telephone survey, 17 people were confused. One of the confused mentioned “they have a lot of them in Southern California” where Opposer is located.

### **B. Trade Dress and Commercial Impression are Relevant**

These proceedings involve federal service mark applications Serial No. 75/214,266 (“the ‘266 application”) and 75/154,590 (“the ‘590 application”) and the ‘266 application and the ‘590 application include “UNA MAS” which include a drawing in typewritten form. As the Board is aware, a Federal application which includes a typed drawing “is not limited to the mark depicted in any special form or lettering.” TMEP § 807.06 and 37 CFR § 2.52(a)(1). Accordingly, the contention by Applicant that these proceedings are based on “registrations and applications which are unstylized” is inappropriate and the contention that commercial impression and trade dress are not relevant is without merit. In view of the fact that the ‘590 application and the ‘266 applications are in typed form, Applicant could adopt a mark which utilizes the same stylized format as Opposer’s mark and claim Federal trademark protection under the Lanham Act. Applicant has in no way limited the marks of these proceedings to any specific stylized format and, therefore, the potential stylized aspects of the marks and the way in which the marks are used are very relevant. Further, this is one of the many reasons why Applicant survey is at most weak.

Trade dress and commercial impression are relevant when considering many of the Dupont factors. In particular, trade dress and commercial impression are relevant, *inter alia*, in the analysis of:

- (1) The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or

in connection with which a prior mark is in use; (3) The similarity or dissimilarity of established, likely-to-continue trade channels; and, (12) The extent of potential confusion, i.e., whether de minimis or substantial.

In re *E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

Obviously, the commercial impression created by the marks themselves is relevant to the analysis of the first DuPont factor. However, the fact that Applicant is using a similar mark in a way which is virtually identical to Opposer also shows that potential confusion is substantial. Showing that Applicant is actually using the UNA MAS mark in a way that is very similar to Opposer reinforces the notion that Applicant is not limited to any one format based on its typed drawing application and that Applicant has in fact adopted and is using its mark in a very similar way for an identical niche market services. Trade dress and commercial impression are also relevant to evaluating the nature of the services and the trade channels. In this respect, the trade dress and commercial impression of Opposer and Applicant shows that both Opposer and Applicant operate restaurants that are identical in format and identical in targeted consumers. The restaurant services of both Opposer and Applicant involve a special niche-type of restaurant that is between a fast-food joint and a full service, sit down restaurant. Both restaurants have the same type of atmosphere which does not include a typical waiter; where the consumer goes to the counter, places their order, and then later picks up their order, and where the food is custom made per the consumer's requests. McCarney Testimony; Page 10, lines 14-25; page 11, lines 1-10; and Exh. 10 and 11. The evidence of trade dress similarities show that Applicant can and has copied Opposer, and if Applicant is allowed to obtain a Federal registration of its mark, Applicant will obtain national rights for use of its mark in any stylized format and for any type of restaurant services.



### C. There are Instances of Actual Confusion

Even with the geographic separation between Opposer and Applicant, incidence of actual confusion have occurred. (McCarney Testimony 95-98 and Exh. 42). The number of instances of actual confusion must be considered in view of the number of opportunities for instances of actual confusion when determining the weight of the evidence. McCarthy on Trademarks §23:14. Under the current factual conditions, the geographic separation between Opposer and Applicant has created limited opportunities for actual confusion to occur, and the fact that some has occurred, further shows there is a likelihood of confusion. Four incidences of actual confusion were found to be persuasive to show a likelihood of confusion when inexpensive goods were involved. McCarthy on Trademarks §23:17 citing *AmBrit, Inc. v. Kraft, Inc.*, 1 USPQ2d 1161 (11<sup>th</sup> Cir. 1986). Opposer and Applicant offer inexpensive Mexican-style food, wherein entrees are priced in the \$5.00 range or below. (McCarney Testimony, Exh. 25-27 for Opposer and the specimen for both the '590 and '266 applications) Both parties compete with fast-food chains for the same consumer. This type of service, namely, inexpensive restaurant service, is purchased casually, is subject to quick consumption and is subject to a lesser standard of purchasing care. *Spoons Restaurants, Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991); *Special Brands* at 1288; *Spice Islands, Inc. v. Frank Tea and Spice Company*, 184 USPQ 35 (CCPA 1974).

In addition, as the Board has pointed out in previous decisions, "the lack of any occurrences of actual confusion is not dispositive inasmuch as evidence thereof is notoriously difficult to come by and, in any event, the test under Section 2(d) of the Trademark Act is likelihood of confusion rather than actual confusion." *Gillette Canada Inc. v. Ranir Corp.*, (TTAB) 23 USPQ2d 1768 at 1774 (6/24/1992) citing *Block Drug Co. v. Den-Mat Inc.*, 17 USPQ2d 1315, 1318 (TTAB 1989) and

*Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738, 742 (TTAB 1978). This is especially true when dealing with inexpensive items. *Id.* at 1774 citing *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597, 1603 (TTAB 1990).

With respect to Applicant's contention that the statements made to Mr. McCarney are hearsay, it is well settled law that these types of statements are not hearsay or are at least an exception to the hearsay rule because the statements go to state of mind which is a core of case. *Kraft General Foods Inc. v. BC-USA Inc.*, (DC EPa) 29 USPQ2d 1919 at 1922 citing *Armco, Inc. v. Armco Burglar Alarm Co., Inc.*, 693 F.2d 1155, 1160 n. 10 [217 USPQ 145] (5th Cir. 1982) (testimony by plaintiff's employees of customers calling for burglar alarm company admissible to show actual confusion); *Arachnid, Inc. v. Medalist Mktg. Corp.*, 1991 U.S. Dist. LEXIS 9055, \*8 [18 USPQ2d 1941 ] (W.D. Wash. 1991) (evidence of customers attempting to order defendant's conversion kit from plaintiff admissible to show customers' confused state of mind), *aff'd*, 972 F.2d 1300 [23 USPQ2d 1946] (Fed. Cir. 1992); *Freddie Fuddruckers, Inc. v. Ridgeline, Inc.*, 589 F. Supp. 72, 76 [223 USPQ 1139] (N.D. Tex. 1984) (company president's testimony about statements of the public admissible to demonstrate customers' confused state of mind), *emphasis added aff'd*, 783 F.2d 1062 (5th Cir. 1986); see also *Fuddrucker's, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 845 [4 USPQ2d 1026] (9th Cir. 1987) (plaintiff's witness testified that customers inquired 100 times a week if plaintiff's and defendant's restaurants had the same owners); *Scandia Down Corp. v. Euroguilt, Inc.*, 722 F.2d 1423, 1431 [227 USPQ 138] (7th Cir. 1985) (Scandia employees testified to many incidents in which customers mistook plaintiff for defendant), *cert. denied*, 475 U.S. 1147 [229 USPQ 560] (1986). As in the above cases, employees or officers of one of the parties are usually

the ones who actually witness the occurrence. Opposer has offered this evidence not to prove the matter asserted, but to show the state of mind of the proponent of the statements.

#### **D. Opposer and Applicant Have Not Coexisted**

As stated above, the POQUITO MAS service mark is used in Southern California, namely, Los Angeles while Applicant operates its chain of Mexican restaurants in Northern California around the San Francisco Bay area. (McCarney Testimony 81, 11-24, 10, 6-8, and Exh. 5, 6, 11 and 29). There are currently no restaurants operated in the same geographic region and therefore there has not been long time coexistence.

#### **E. POQUITO MAS is a Strong Mark**

POQUITO MAS is a creative use of two Spanish words and has been in use for more than 18 years in connection with Opposer's restaurants in the Los Angeles area. Further, Opposer has had many articles written about its restaurant in the Los Angeles Times which is a major newspaper in one of the largest cities in the world. (ONOR 5, Att 2, 3, 9 and 11). Opposer has also been written about in the Daily News of Los Angeles for many years. (ONOR 2, Att 15-31). As with many other restaurants, including Opposer's and Applicant's, word-of-mouth is a large part of the advertisement for these services. *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531 at 1534 (C.A.F.C. 1997) citing *Giant Food, Inc v. Nation's Foodservice, Inc.*, 218 USPQ 390, 395 (C.A.F.C. 1983). More than 18 years of favorable reviews, word-of-mouth advertisements and other promotions in this major metropolitan area have made Opposer's POQUITO MAS marks strong for its restaurant services.

**F. The Testimony of Christine P. Peters Includes Inadmissible Hearsay Evidence and Does Not Show that POQUITO MAS is Weak**

Applicant is attempting to enter material relating to alleged other restaurants which is inadmissible and Opposer again objects to the evidence and requests that it be stricken from the record. The Peters testimony in question relates to several telephone calls that she made based on written questions created by Applicant. Peters test. Page 6, line 16 and Page 14, lines 12-21. The two written questions were directed to whether the establishment is a restaurant which sells Mexican food and whether the restaurant would fax a menu. Peters test. Page 14, lines 12-21. Once the two questions were answered, the telephone call was ended. Peters test. Page 14, lines 19-24. No questions were asked to determine what style of restaurant was involved, namely, whether the restaurant was Mexican, Italian or even Japanese which includes a single Mexican dish. Peters test; Page 15, lines 14-18. No questions were asked to determine what type of restaurant was involved, namely, whether the restaurant was an expensive, sit down restaurant or a fast-food restaurant. Peters test; Page 15, lines 14-18. Peters did not visit these establishments and her testimony concerning whether these establishments are restaurants which serve Mexican food is solely based on statements by the declarant on the telephone. Peters test; Page 20, lines 22-25. This evidence is hearsay. Peters is offering the testimony to prove the matter asserted by the declarant, namely, based on the declarant's statements, that the establishment is a restaurant and it serves Mexican food. This is not a survey which as the Board knows requires stringent safeguards to overcome the hearsay problems and to create trustworthy data. Further, Opposer was not given the opportunity to question these declarants to determine the truth of the assertions and to obtain other relevant information including, whether Mexican food is a primary food of the establishment, whether there is sit down

service, whether the entrees are expensive or inexpensive, or whether the establishment is even a restaurant at all. Peters even testified that she has no way of knowing what percentage of the establishment's business is Mexican food. Peters test. Page 21, lines 4-6. Peters cannot even testify as to whether the establishment offers take-out service. Peters test. Page 21, lines 10-12. The testimony of Peters which relates to the telephone calls should be stricken from the record. The "Peters Declaration" is merely a self-serving document of alleged telephone calls and should also be stricken from the record.

After obvious extensive searching, Applicant can only provide credible evidence of five operational restaurants that use a service mark. However, only three include the use of the word MAS as a service mark. One of the two which fails to show MAS used as a service mark is Exhibit 4 which is a restaurant named MASA, not MAS. MASA is a different Spanish word having an English translation of "dough," not "more." Peters Exh. 4 and Applicant's First NOR Att. 1. Exhibit 3 of the Peters' testimony fails to show service mark use of any mark. In this respect, there is no mark on what appears to be only one page, not the front page, of a menu. Peters Exh. 3. There is no service mark which is a part of the actual menu. Of the three remaining restaurants, one is a Japanese restaurant, not a Mexican restaurant. Peters Exh. 8. Even the three menus fail to show the extent and/or duration of use. There is no way to tell whether these establishments are anything more than very small places that have little or no market significance.

Attachments 6 and 7 from the Peters testimony do not show use of a service mark for restaurant services. Referring to attachment 6, presented is a printout from a database. This printout is not a clipping from a telephone book as is alleged by Applicant's attorney. This printout is not a list of restaurants found on the Internet. This printout is nothing more than a list of non-confirmed

data. Applicant's self serving statements by an non-expert does not support the contention that the database list shows service mark use in connection with restaurant services. In addition, there is no way to tell whether an establishment actually existed at the time of the search nor is there any way to determine what mark the establishment actually used in connection with its services or exactly what services the establishment provides. Further, there is no way to fully understand the extent of use, if it existed at all. In fact, Peters testified that an undisclosed number of establishments in the list were never reached by telephone. Peters test. Page 14, line 25 and Page 15, lines 1-8. While Peters could not remember how many were not able to be contacted, it can only be assumed that it is a significant number since only five menus were obtained. The remainder of Peters's testimony is merely self serving hearsay testimony that cannot be corroborated and should be stricken.

Referring to Attachment 7, Applicant is trying to use third party registrations to show that Opposer's mark is weak. It is well established that third party registrations do not show use of the mark of the registration, they also don't show the way in which the mark is used or the extent of use. "[A]s to strength of a mark, . . . registration evidence may not be given any weight." *Olde Tyme Foods Inc. v. Roundy's Inc.*, (CA FC) 22 USPQ2d 1542 (4/17/1992) citing *AMF Inc. v. American Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the marketplace or that customers are familiar with them . . ."). Accordingly, the third party applications or registrations should at most be given no weight concerning the strength of Opposer's mark.

Even if the database printouts are considered, they do not show that the POQUITO MAS mark is weak. Only 13 establishments were found in Applicant's extensive search and virtually no information is even known about these establishments. Applicant has included a discussion of the

list in its brief which likely represents the ones which Applicant believes to be the closest. The discussed portion of the list includes nine entries wherein the record does not include nine menus, nine web pages, or nine photos showing use. These establishments may not be in operation or may be very different than the restaurant services involved in these proceedings. The alleged establishments could even be small enough to command little or no trademark significance. Further, both searches turned up both the marks of Opposer and Applicant.

Turning to the entries themselves, the majority are very different than the marks involved in these proceedings. As is stated above in greater detail, the marks of Opposer and Applicant involve marks with two word wherein both words have clear Spanish origin. The two words also work together to create a meaning and commercial impression relating to “more.” The entries of the list do not include such marks (MAS TORTILLA GRILL, MAS AMIGOS MEXICAN RESTAURANT, EL MAS CAFÉ, MAS RESTAURANT, OTRA MAS, MAS FAJITAS, BURGER Y MAS MUCHO MAS, ENCHILADAS Y MAS and LATINO Y MAS SPANISH CUISINE). The entry which is the closest is a mark owned by Opposer. In this respect, Applicant has referenced the mark MUCHO MAS in its brief as a third party mark showing weakness in Opposer’s mark but, Applicant has also entered into the record Opposer’s application to register the MUCHO MAS mark. While not plead, MUCHO MAS is a service mark of Opposer and Opposer has filed a Federal service mark application (S.N. 76/346,771) for the MUCHO MAS mark. Applicant’s SECOND NOR Att. 1.

#### **G. Actual versus Recited services**

While the registrations owned by Opposer and Applicant subject to these proceedings recite restaurant services, the analysis goes beyond the recited services. One of the factors to determine whether a likelihood of confusion exists is “the extent of potential confusion, i.e., whether

de minimis or substantial.” *DuPont DeNemours*, 177 USPQ 563, 567. The record supports that both parties operate the identical type of special Mexican restaurant services. Both parties offer freshly prepared Mexican food for prices which compete with fast-food restaurant. Both parties offer these services in a similar casual atmosphere. Both offer menus which are very similar. If these parties were to operate restaurant in the same geographic location, the potential for confusion is significant.

## II. SUMMARY

Opposer is not asking for a broad scope of protection. Opposer is asking the Board to prevent the registration of a mark which is used by Applicant in connection with services which are identical in every conceivable way. They are not merely identical because the recitations are identical, they are identical because the use by each party is identical. Freshly prepared Mexican food served quickly at fast-food prices in a casual atmosphere.

Of the 13 DuPont factors, Applicant has conceded many and could only argue three factors. The remaining factors strongly weigh in Opposer’s favor. In fact, even the three factors discussed by Applicant weigh strongly in Opposer’s favor. Accordingly, as is set forth above, when all of the factors are considered, there is a likelihood of confusion. Further, if there is any doubt as to whether a likelihood of confusion exists, it is to be resolved against Applicant who is the newcomer. *Special Brands* at 1285 citing *Planter's Nut & Chocolate Company v. Crown Nut Company, Inc.*, 134 USPQ 504 (CCPA 1962). “The newcomer has the clear opportunity, if not the obligation, to avoid confusion with the well-known marks of others.” *J & J Snack Foods Corp. v. McDonald's Corp.*, 18 USPQ 1889, 1892 (Fed. Cir. 1991).



### III. CONCLUSION

Opposer has established and Applicant has conceded that Opposer has priority in that Opposer has both used and registered its POQUITO MAS mark long prior to the filing of either the UNA MAS or ONE IS GOOD, BUT UNA MAS IS BETTER applications of Applicant. It is also respectfully submitted that Opposer has established that a likelihood of confusion exists as a matter of law. Each of the *DuPont* factors weighs heavily in Opposer's favor.


### IV. RELIEF REQUESTED

For all the above reasons, registrations of UNA MAS and ONE IS GOOD, BUT UNA MAS IS BETTER will cause confusion, cause mistake or deceive the purchasing public as to the source of the restaurant services. Therefore, under 15 U.S.C. § 1052(d), Applicant is not entitled to obtain trademark registrations for either UNA MAS or ONE IS GOOD, BUT UNA MAS IS BETTER. Opposer again respectfully requests that these consolidated opposition proceedings be sustained and each of Applicant's applications be refused.

Respectfully submitted,

FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP

Date: 2/26/3

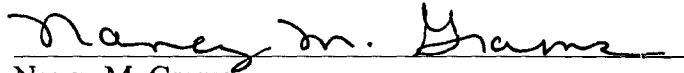
  
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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing OPPOSER'S REPLY BRIEF was served on Applicant's Attorney by First Class, U.S. Mail, postage prepaid, at the below-stated address:

David J. Brezner, Esq.  
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on this 26<sup>th</sup> day of February, 2003.

  
Nancy M. Grams